

### **REMARKS**

The specification has been amended to remove the objected to reference to “claim 1” at page 2, line 27.

Claims 1-26 are pending in this application. Claims 14 -23 have been withdrawn from consideration. It is noted that claim 24 (dependent on elected claim 12) that was added by the preliminary amendment filed October 19, 2005, was improperly omitted from the Restriction Requirement mailed March 26, 2008. As claim 24 depends from claim 12, it is respectfully submitted that this claim should have been included with claims 1-13 (of Group I) that were elected on April 28, 2008. Accordingly, claim 24 is included as a pending claim and is being treated as an elected claim. Moreover, the outstanding Action is noted to be incomplete as pending claim 24 has not been properly considered.

Claims 1-13 and 24 have been amended to remove all reference numerals. In addition, claim 1 has been amended to improve clarity without changing the scope thereof such that no new matter has been introduced. New claims 25 and 26 have been added that are fully supported by original Figures 12-15 and by the paragraph bridging pages 17 and 18 of the specification with regard to new claim 26. Accordingly, it is respectfully submitted that the present amendment does not introduce any new matter.

### **Objection to the Specification**

Page 2, line 27, of the specification was objected to for referring to claim 1. As noted above, the specification has been amended to remove this objected to reference to “claim 1.” Accordingly, withdrawal of this objection to page 2, line 27, of the specification is respectfully requested.

### **Claim Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-13 were rejected under the second paragraph of 35 U.S.C. § 112 at page 2 of the outstanding Action based upon the allegation that base independent claim 1 recites “a main surface of the holding device (11) are predetermined in a fixed manner and are different from

each other” and that this language is indefinite and vague because it “is not clear what applicant is referring to by ‘predetermined in a fixed manner and are different from each other.’”;etc.”

The first error in this rejection is that the reason offered has improperly dissected the actual limitation and taken only part of the actual claim language out of context. This dissection and viewing of the dissected language in a vacuum is clearly prohibited by the PTO’s own MPEP guidelines as well as by the controlling case law set forth by these MPEP guidelines. Note MPEP §2173.02 that sets forth the “test for definiteness under 35 U.S.C.112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).” Clearly, reading only an incomplete extraction from a clause of claim 1 in a vacuum as is done in the outstanding Action does not fall within this recognized test for definiteness.

The particular claim 1 clause being questioned actually recited that “the feed device (7, 8, 9) and the removal device (8, 22) are arranged relative to the holding device (11) in such a manner that a first angle between the feed direction and a main surface of the holding device (11) and a second angle between the removal direction and the main surface of the holding device (11) are predetermined in a fixed manner and are different from each other.” This previous recital made it clear that it was the recited “first angle between the feed direction and a main surface of the holding device (11) and a second angle between the removal direction and the main surface of the holding device (11)” (emphasis added) that “are predetermined in a fixed manner and are different from each other,” not the “main surface of the holding device (11)” as apparently misinterpreted by the outstanding Action. Thus, even without the required consideration of the specification and the indicated exemplary reference numerals 7, 8, 9, 11, and 22, the claim language was clear enough when considering the clause as a whole.

Nevertheless, to provide an even clearer statement of this claimed subject matter, claim 1 now recites “the holding device has a fixed orientation relative to the feed device and to the removal device” and requires the feed device and the removal device to be “arranged relative to the holding device in such a manner to define a first angle between the feed direction and a main surface of the holding device and a second angle between the removal direction and the main

surface of the holding device, the first and second angles being predetermined in a fixed manner and being different from each other.” There is absolutely no question that it is the recited “first and second angles” that must be “predetermined in a fixed manner” while also “being different from each other,” and the withdrawal of the rejection of claim 1 under the second paragraph of 35 U.S.C. § 112 is, thus, respectfully requested.

As claims 2-13 were apparently only included in this rejection because they depend from claim 1, the withdrawal of this rejection of claims 2-13 under the second paragraph of 35 U.S.C. § 112 is, thus, also respectfully requested.

### **Claim Rejection Under 35 U.S.C. § 102**

Claims 1-3, 5-6, 8-11, and 13 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,251,425 to Kern (hereinafter “Kern”). This rejection is traversed.

It is clear that the “packing trap 13” of Kern is improperly equated to the claim 1 recited “holding device” at page 3 of the outstanding Action. In this regard, the “packing trap 13” of Kern is not taught or suggested to have a fixed orientation relative to the feed device (read as being via 15, 16, 19, and 20 of Kern at page 3 of the outstanding Action) and the removal device (read as being via 20, 21, 43, and 44 of Kern at page 3 of the outstanding Action) or to be arranged relative to the feed device and the removal device with the claim 1 recited first angle and second angle. More specifically, the first angle that must be between the feed direction and a main surface of the holding device and the second angle between the removal direction and the main surface of the holding device that must be “predetermined in a fixed manner,” while also being different, are also not taught or suggested.

As the outstanding Action appears to have confused this previous recital as to the relationship between the holding device and the feeding and the removal devices, the above-noted clarification has been added to claim 1 so that it is unmistakable that the holding device has “a fixed orientation relative to the feed device and to the removal device” and that “the feed device and the removal device are arranged relative to the holding device in such a manner to define a first angle between the feed direction and a main surface of the holding device and a

second angle between the removal direction and the main surface of the holding device,” with “the first and second angles being predetermined in a fixed manner and being different from each other.” Instead of teaching or suggesting that “packing trap 13” has any “fixed orientation relative to the feed device and the removal device with the claimed “first and second angles being predetermined in a fixed manner and being different from each other,” the Kern “packing trap 13” must be pivoted about the rotation point 22 as explained at col. 2, lines 25-66.

Accordingly, as the Kern “packing trap 13” cannot be reasonably equated to the claim 1 holding device, there is no anticipation under 35 U.S.C. §102(b) and withdrawal of this improper rejection as applied to amended claim 1 is respectfully requested.

As claims 2, 3, 5-6, 8-11, and 13 all depend ultimately on claim 1, the rejection of these dependent claims as being allegedly anticipated by Kern under 35 U.S.C. § 102(b) is traversed for the reasons noted above as to parent independent claim 1.

In addition, these dependent claims all set forth further features that are clearly not taught or suggested by Kern. For example, dependent claim 3 recites that “the feed device comprises a guide element with a discharge point, the guide element being convex at its discharge point.” While the guide elements 15 and 16 of Kern (that are relied upon in the outstanding Action to meet these claim 3 limitations) have convex portions, these convex portions are at respective entrance portions not associated with any discharge point that is taught by Kern. Accordingly the rejection of dependent claims 2, 3, 5-6, 8-11, and 13 as being allegedly anticipated by Kern under 35 U.S.C. § 102(b) is traversed because it also fails to teach or suggest all of the features added by these dependent claims in addition to not teaching or suggesting all the features required by amended base independent claim 1.

#### **Claim Rejections Under 35 U.S.C. § 103**

Claims 4, 7, and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kern. This rejection is respectfully traversed.

First, it is noted that claims 4, 7, and 12 all depend from amended independent base claim 1 and that the rationales offered to reject these claims do not cure the above-noted deficiencies of Kern as to not teaching or even suggesting all the subject matter recited by this amended

independent base claim. Thus, the rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern is improper for at least this reason.

In addition, the rationales offered to reject claims 4, 7, and 12 are also all in error for relying on an improper substitute for the showing of substantial evidence required under the Administrative Procedures Act. *See In re Lee*, 217 F.3d 1365, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) as follows:

Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:

5 U.S.C. 706(2) The reviewing court shall

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

\* \* \* \*

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute

Rather than provide the “substantial evidence” showing required by the Administrative Procedure Act as to claim 4 subject matter, the outstanding Action attempts to misuse the doctrine of Official Notice as a substitute for this required production of “substantial evidence.”

First in this regard, the court in *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) specifically noted that “[w]ith respect to core factual findings in a determination of patentability, however, the [PTO] . . . must point to some concrete evidence in the record in support of these findings.” The courts have further established that “official notice” **cannot** be used as to assertions of technical facts in the areas of esoteric technology as attempted here. *See In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (CCPA 1970). Thus, in further accordance with *Ahlert*, the PTO is called upon to provide a citation to some reference

work recognized as standard in the envelope insertion art to substantiate its assertion or a declaration/affidavit by the Examiner.

Furthermore, even if the PTO produces a standard reference work from the envelope insertion art or a declaration by the Examiner, this would only establish that the use of a vacuum guiding plate is known, without the required “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” ( *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ.2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006)) as to modifying the guide plate 16 arrangement of Kern. In this regard, the outstanding Action simply asserts that a vacuum guide plate would be somehow less subject to jams than the existing Kern arrangement using hold down elements 14 and 15 to ensure that the envelope is fed along a guide plate 16. Conjecture as to all vacuum guide plates having superior jam resistance relative to the existing Kern guide plate arrangement is just that, conjecture based on assumptions. Assumptions cannot be substituted for required showings of actual evidence. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

Also, a substantial redesign of the Kern arrangement using hold down elements 14 and 15 to ensure that the envelope is fed along a guide plate 16 would be required as there is a need to control the vacuum along the guide to permit moving the envelope against the restraining vacuum force with the eventual release of the envelope from the guide plate also being required. Completely absent from the rationale of the outstanding Action is the manner of this vacuum control and eventual vacuum release not to mention that such a complete redesign to reach a different operation is contrary to a finding of obviousness under established precedent. *See In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

With regard to claim 7, the outstanding Action cites a pre-1952 decision for a tenet of law it does not contain. The cited case of *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) does not say that “rearranging parts of an invention involves only routine skill in the art” as incorrectly asserted in the paragraph bridging pages 5 and 6 of the outstanding Action. Instead, the court there noted that under the facts in that case the movement of a switch position was found to lack patentable merit because this shifting of the position of the switch would not have modified the operation of the device. As more recently noted by the PTO reviewing court

in *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995) “[t]he test of obviousness . . . requires that one compare the claim's “subject matter as a whole” with the prior art “to which said subject matter pertains.” As further noted here by the court, “[t]he inquiry is thus highly fact-specific by design.” Accordingly, 35 U.S.C. § 103 requires the PTO to do more than simply cite precedent as establishing a binding rule applicable to all fact situations. As the outstanding Action simply relies on the misstatement of a supposed “rule” improperly derived from *In re Japikse*, no *prima facie* case of obviousness has been established based thereon and the withdrawal of this improper rejection of claim 7 is respectfully requested.

Similarly, the rationale offered to support the rejection of claim 13 lacks any citation of supporting evidence or case law authority for reaching the completely unwarranted subjective conclusion that the subject matter of claim 13 is somehow an obvious “engineering design choice.” This is exactly the type of baseless subjective conclusion that the PTO reviewing court found to be completely without merit in the above noted *Lee* decision. Again, as no proper *prima facie* case of obviousness has been established, the withdrawal of this improper rejection of claim 13 is also respectfully requested.

**Conclusion**

In view of the above remarks, Applicant believes this pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present Application, the Examiner is respectfully requested to contact Raymond Cardillo, Reg. No. 40,440, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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